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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,988	12/20/2001	Kazuo Tsuge	S2856-0024/P024	1223
7590	08/10/2006			EXAMINER ARAQUE JR, GERARDO
Steven I. Weisburd DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 41st Floor 1177 Avenue of the Americas New York, NY 10036-2714			ART UNIT 3629	PAPER NUMBER

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/026,988	TSUGE, KAZUO	
	Examiner	Art Unit	
	Gerardo Araque Jr.	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 July 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. 2000-390810, filed 12/22/2000. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e),

120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Information Disclosure Statement

2. The information disclosure statement filed August 25, 2003 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance,

as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1- 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. (US Patent 5,310,997) in view of Murrah et al. (US Patent 5,804,807).**

In regard to **independent claims 1, 4, 7, and 8**, Roach discloses a shopping system with a portable unit (Column 3 Lines 53 – 58), an information kiosk located throughout the store (Column 8 Lines 55 – 59), a computer system at a remote location with the system connected on a Local Area Network (LAN) (Column 3 Lines 59 – 65). Moreover, Roach discloses that the product information is entered into the computer system through the use of a light pen or through the scan gun (Column 12 Lines 13 – 16). The transmissions that are sent contain the customer and merchandise numbers so that the information can be retrieved to build a sales transaction, which are stored on a database (Column 2 Lines 19 – 29) connected to the network. Furthermore, it is inherent that a kiosk connected to a network will require some type of identification number in order to properly communicate with the central computer.

Roach teaches all of the elements claimed with the exception of utilizing a wireless network as the method of transmitting data throughout the store. The examiner takes Official Notice that having a wireless network is old and well established in the business of setting up networks as a convenient way of avoiding extensive wiring, routing of wires, and cost of implementing the wires. Moreover, having a wireless network would allow more people to access a wireless apparatus without the hassle of waiting for someone to finish their usage of the apparatus if it were not wireless.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have included a wireless network as the principal method of transmitting data because a skilled artisan would have recognized that this business practice would increase the number of kiosks that would be available on the sales floor, allow the transmitted information be available more readily throughout the store, and increase the number of consumers able to access the network and kiosks with the use of portable terminals. (Note: Further evidence that wireless networks with portable terminals in a shopping environment were known at the time of the applicant's invention is provided by Murrah et al. US Patent 5,804,807).

3. In regards to **claim 2**, Roach discloses that information kiosks are interspersed throughout the store (Column 8 Lines 55 – 59 <http://webster.com/cgi-bin/dictionary?va=interspersed>).

4. In regards to **claim 3**, the transmissions that are sent contain the customer and merchandise numbers so that the information can be retrieved to build a sales transaction, which are stored on a database (Roach Column 2 Lines 19 – 29) connected

to the network. Furthermore, it is inherent that a kiosk connected to a network will require some type of identification number in order to properly communicate with the central computer.

5. In regards to **claim 5 – 6 and 9 - 10**, Roach discloses that each computer is a handheld personal computer that includes an infrared light pen (Roach Column 5 Lines 45 – 47). Moreover, each computer communicates with a server via RF transmission (Roach Column 5 Lines 54 – 55).

Response to Arguments

6. Applicant's arguments filed December 20, 2001 have been fully considered but they are not persuasive.
7. In regards to the argument made on **Pages 2 – 3**, the examiner acknowledges priority to JAPAN 2000-390810, but the applicant is still required to mention the priority in the first sentence of the specifications as is discussed above. Furthermore, regarding the Information Disclosure Statement the applicant argues, "This translated portion meets the requirements set forth in the MPEP for the statement of relevance." However, as discussed in the MPEP, "Where the information listed is not ~~in~~ in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. ... The requirement for a concise explanation of non-English language information would not be

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satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120."

In regards to the argument made on **Pages 4 – 5**, the applicant argues that Roach fails to teach, "...a wireless apparatus provided for each product displayed within a store and communicating with the portable user terminal." However, the examiner has pointed out that Roach discloses interspersed information kiosks located throughout the store to give the customer **specific product information**. Moreover, Roach further teaches the use of a portable terminal. However, as previously discussed Roach does indeed fail using a wireless network to carry out all of these processes.

However, as the examiner has pointed out having a wireless network is old and well established in the business of setting up networks as a convenient way of avoiding extensive wiring, routing of wires, and cost of implementing the wires. Moreover, having a wireless network would allow more people to access a wireless apparatus without the hassle of waiting for someone to finish their usage of the apparatus if it were not wireless. Further still, the examiner also pointed out that Murrah teaches a similar system as Roach with the exception of having the interspersed information kiosks, but does teach the usage of a wireless network with a portable terminal that is in communication with the central processor. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have included a wireless network as the principal method of transmitting data because a skilled artisan would have recognized that this business practice would increase the number of kiosks that would be available on the sales floor, allow the transmitted information be available

more readily throughout the store, and increase the number of consumers able to access the network and kiosks with the use of portable terminals.

In regards to the argument made on **Page 6**, the applicant argues that neither Roach or Murrah teach a, "...request being made when a portable terminal comes within a prescribed distance of anything." However, it is inherent that devices having wireless capabilities within a wireless network are only able to carry out their intended function when they are within range. For example, a cellular phone can only make a call when they are within range of a cellular tower. Once the phone has left the tower's range the phone is not able to make a call. As a result, if the portable terminal in the wireless network were to leave the store it would be highly unlikely that the portable terminal would be able to gather the necessary information that the customer requires. In regards to Roach and Murrah not teaching requesting information, it is obvious that if the **information kiosks** as disclosed by Roach provide **specific product information** one must make a request. If no requests were made about specific products why would **information kiosks** that provide **specific product information** be interspersed throughout the floor?

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600